

REMARKS

1. All previously pending claims were cancelled and newly submitted claims 175-197 are presented herein. It is believed that these newly submitted claims overcome each of the rejections of the previously submitted claims as discussed below.

Claim Rejection 35 USC 101

2. In paragraphs 2-3 of the Final Office Action, the Examiner rejected claims 1-13, 17-30, 32, 37-72, 75, 77-114, 115-130, 138-150, 153 and 155-174 under 35 USC 101 as being directed to non-statutory subject matter.

New claims 175-186 are written as method claims, which recite more than abstract ideas and which in fact effect a concrete, useful, tangible result. Insofar as the United States Supreme Court has recognized that patentable subject matter extends to “anything under the sun that is made by man,” *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 100 S.Ct. 2204, 65 L.Ed.2d 144 (1980), and the Federal Circuit has established that there is no such thing as a “business method exception,” *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375-77 (Fed. Cir. 1998), it is respectfully submitted that method claims 175-186 are within statutory subject matter.

Claims 187-197 are apparatus claims reciting memory equipment, data processing equipment, and the like, performing certain useful functions, and therefore clearly fall within statutory subject matter.

Claim Rejection- 35 USC 103(a)

3. In paragraphs 4-5 of the Final Office Action, the Examiner rejected claims 1-174 under 35 USC 103(a) as unpatentable over Arbuckle in view of Slotznick, and further in view of Krim. The Examiner characterized Arbuckle as disclosing all the elements of Applicant's claim 1 except for the ability to provide a plurality of participants with the ability to effect choices about the care of said participants and choices determined by said participants. The Examiner cited the Slotznick reference as an intelligent agent to allow the participant to effect choices about the care of said participants and choices determined by said participants.

The applicant respectfully disagrees with the Examiner's characterizations of Arbuckle and Stotznick. Specifically, Arbuckle is essentially an email notification system of a person's death, and deals only with situations occurring after a person has died. It does not disclose or even suggest a system with the capability of allowing a participant to submit information relating to personal care, such as health or medical care, to be administered to the participant *prior to death*, in the event the participant is incapacitated. Nor does Arbuckle disclose or suggest a system in which a participant receives information regarding alternative choices, treatments, or actions available in response to a given end-of-life condition and selects a desired choice of care corresponding to such condition. Nor does Arbuckle disclose or suggest a system which provides an information product carrying out the participant's desired response to an end-of-life condition, as activated by a user aware of the participant's incapacitated state. In fact, Arbuckle expressly teaches away from this latter point, and discloses only a system that monitors various databases and resources for reports of death and then sends out an

email notification that a person has died when there is a match.

In the prior Office Actions, it appears that the Examiner did not take the position that Arbuckle discloses a system as described in the preceding paragraph, but rather it appears based his rejections on the “vast breadth” of the previously pending claims (p.9, ¶ 6(B)) and stated that the claims “do not reasonably convey the concept the applicant disputes” (p.7, ¶ 6(A)). The Examiner also stated that the Applicant had not pointed to any section of the specification in which various terms, such as “end of life,” “advance directive,” and the like are defined. (p.7, ¶ 6(A)) Therefore, without explicit definitional guidance, it appears the Examiner construed the claims as broadly as the terms would allow, and so construed, the Examiner found the previously pending claims obvious for the reasons stated in the prior Office Actions.

In response to the previous rejections and the Examiner’s reasons therefor, the Applicant has submitted new claims that convey the inventive concept more concisely and clearly, and in particular which convey various features and functions not present in Arbuckle, Slotznick, or Krim, or any combination thereof. Applicant has further amended the specification to insert definitions at the beginning of the detailed description. It should be noted that the terms defined, and their definitions, were found in the original specification as filed, but have been grouped together for clarity and convenience. No new matter has been added. It is respectfully submitted that the applicant, even from the initial filing, is its own lexicographer with respect to the defined terms. To the extent it was not clear before, with the amendments to the claims and express definitions, the Applicant submits that it is now clear that Arbuckle, either alone or viewed in combination with Slotznick and Krim, does not teach or solve the problem

solved by the instant invention and does not disclose each and every element of the claimed invention.

4. In particular, new claim 175 contains the following elements in the body of the claim:

receiving via an interactive interface from an input user end-of-life information relevant to the future care of a participant should said participant prior to death become incapacitated;

providing via said interface guidance information corresponding at least in part to said received information;

enabling said input user via said interface to select choices regarding said care, said end-of-life information comprising said selected choices;

storing in a computer-readable registry said end-of-life information in the form of an information set corresponding to said participant;

upon receipt of a verified request from a user aware of the occurrence of said incapacitated state in said participant, producing an information product derivative of said information set comprising in an enforceable form said participant's desired response to said incapacitating condition; and

communicating said information product to an output recipient.

Arbuckle does not disclose end-of-life information (as defined in the specification, i.e., not an obituary or death notice) relevant to the future care of a participant should said participant *prior to death* become incapacitated. Arbuckle does not disclose providing via said interface guidance information corresponding at least in part to said received information. Arbuckle does not disclose enabling said input user via said interface to select choices regarding said care, said end-of-life information comprising said selected choices. Arbuckle does not disclose receipt and storage of the type of information

received and stored in the instant invention. (Basically, Arbuckle discloses receiving and storing identity and contact information so that various designees can be notified if the system comes across a death notice in one of the sources it monitors). Finally, Arbuckle does not disclose upon receipt of a verified request from a user aware of the occurrence of said incapacitated state in said participant, producing an information product derivative of said information set comprising in an enforceable form said participant's desired response to said incapacitating condition.

Because the Examiner relied on Arbuckle as the primary reference, and Arbuckle is clearly distinguished herein, it is believed that Applicant has addressed Examiner's prior rejections and new claim 175, and all claims dependent therefrom, are allowable. Nevertheless, in the interest of being thorough, Applicant addresses the other bases for rejection in paragraph 5 of the Final Office Action.

5. With respect to the Slotznick reference, the Examiner stated that he relied upon Slotznick "solely for the teaching of 'the ability to effect choices about the care of said participants,'" a limitation recited only in the preamble of now-cancelled claim 1. (p. 9, ¶ 6(B)). Insofar as body of new claim 175 discloses the method by which such choices are effected, and Slotznick does not disclose an element of that method, the applicant submits that Slotznick does not disclose "the ability to effect choices about the future care of said participants" as claimed.

6. In paragraph 5(A) of the Final Office Action, the Examiner cited Krim (at p.5, ¶ 0063-0066) as disclosing "said information relating to the care of said plurality of

participants and determined by said plurality of participants.” The singular reference in the cited paragraphs of Krim relate only to a “library of resource centers” that is strictly informational, in other words, that merely passes along content. In contrast, the present invention enables a user through its interface to make affirmative choices regarding end of life care, and then upon request produces an “enforceable information product” derived from the information provided and choices made by or on behalf of the participant, using the invention. The “library” disclosed in Krim provides nor suggests no such functionality or utility.

7. The rejection stated in paragraph 5(B) of the Final Office Action is not applicable to the new claims, but insofar as it relates to the “care of the participant” is addressed above.

8. The rejection stated in paragraph 5(C) of the Final Office Action, relating to Krim suggesting “said information relating to the care of said plurality of participants and determined by said plurality of participants” is addressed above.

9. In the interest of brevity, new apparatus claim 187 contains language and limitations similar to those in new method claim 175, and Applicant incorporates the preceding remarks as applicable to claim 187 and all claims dependent therefrom.

The applicant submits that the present claims are allowable over the prior art of record. It is believed the application is therefore in condition for allowance, and

such action is respectfully requested. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (205) 521-8766 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date

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